

REMARKS:

In the Response dated July 31, 2003, applicant argued that the rejection of Claims 1, 2, 5-9, 17-22 and 24-30 under 35 USC 103(a) as being unpatentable over Weed in view of Puchalski and Jakobson was improper in view of MPEP (2141) which states that:

*When applying 35 USC 103, the following tenets of patent law must be adhered to:*

*(A) the claimed invention must be considered as a whole;*

*(B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;*

*(C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and*

*(D) reasonable expectation of success is the standard with which obviousness is determined.*

It is further noted that, MPEP 2141.02 states that "a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention."

As noted in the afore-mentioned response, the examiner's statement on page 5 of the Office Action dated June 4, 2003 that "Weed provides no teaching or suggestion that the particular method disclosed therein is the only method to employ oatstraw. One of ordinary skill in the art would understand that oatstraw contains beneficial ingredients and would have been motivated to employ oatstraw in method other than those expressly disclosed by Weed" is in conflict with MPEP 2141, particularly points (B) and (C). Specifically, the fact that Weed does not state emphatically that this is the only method does not and cannot mean that Weed therefore discloses all other methods of employing oatstraw, including those methods that Weed does not describe or suggest. That is, Weed does not teach or suggest filtering oatstraw; rather, the entire document is focused on uses of whole oatstraw. Thus, any teaching or suggestion of filtering or extracts is inconsistent with Weed as a whole.

Furthermore, the examiner appears to be admitting that Weed does not teach or suggest filtering an aqueous extract of oatstraw and using same as a topical lotion as described by applicant but is then concluding that this would have been obvious. The examiner however provided no sections in Weed nor any additional references supporting this position. Applicant is justifiably concerned that the examiner is considering Weed in hindsight in view of applicant's disclosure and is not considering Weed in its entirety as per MPEP 2141.

In the Advisory Action dated August 29, 2003, the examiner stated that "the removal of oatstraw is an obvious alternative (see the prior office action, page 5). Applicant's attention is noted to Weed, page 205, wherein other option without oatstraw reside is disclosed", referring to the oatstraw infusion.

It is noted that the non-relevance of the infusion was discussed in the response dated July 31, 2003. Furthermore, as noted above, the section on page 5 of the Office Action was believed to be contrary to MPEP 2141, as discussed above.

Applicant's representative therefore contacted the examiner by telephone to discuss these matters in an attempt to have the Final Action removed.

It is noted that in the telephone interview of October 6 with the undersigned, the examiner agreed that the oatstraw infusions and tinctures described by Weed were not relevant to applicant's invention because the oatstraw infusion was prepared by baking and browning an oatcake like coffee, then pulverizing the cake and making it into a coffee or infusion and the tincture was arranged to be ingested, not applied topically.

In this telephone interview however, the examiner stated that the statement "Boil water and pour over oatstraw in a large tub. When cooled sufficiently, bathe. (Yes, with the oats and all.)" (Weed, page 205) was not a "strong statement" and implied that it was not a necessary step to include the oats in the tub.

As discussed during the telephone interview, applicant does not agree with this position. Specifically, Weed states "yes, with the oats and all". There is nothing in that statement that implies that this is an optional step or that there is a choice involved. Furthermore, there is nothing in Weed which teaches or even implies

filtering to remove the oatstraw residue from an aqueous extract.

Specifically, Weed states that the oats must be present. There is no statement that implies that filtering may be done. Furthermore, this would be inconsistent with the teachings of Weed as a whole which is focused on the benefits of whole oatstraw. Applicant simply cannot understand how this can be considered anything but a "strong statement" and that on this basis Weed teaches against filtering.

Furthermore, since the telephone interview, applicant's representative has carried out a search of the case law and appeal decisions for the term "strong statement" and has not been able to locate other usage of this term or a definition thereof. As such, it is unclear exactly what the examiner would consider to be a strong statement as there does not appear to be a definition for same.

Furthermore, even if this is held to not be a "strong statement", the fact remains that Weed does not teach, describe or suggest the desirability of filtering the aqueous oatstraw extract and that filtering and/or extracts go against the teachings of Weed when taken as a whole, as discussed above.

Applicant is respectfully concerned that the examiner is of the opinion that the instant invention is not patentable and is maintaining an objection which is not supported by the cited art. Specifically, applicant maintains that Weed is not a proper 35 USC 103(a) reference in view of the amended claims because as discussed above and in the previous response, Weed does not teach or suggest filtering an aqueous extract of oatstraw.

It is also noted that on at least two occasions (when arranging the telephone interview of October 6 and during the interview of October 6), the undersigned has requested that the examiner discuss this situation with a superior. Both times, this request has been rebuffed.

It is noted that the inventor is at a critical stage in the commercialization of this invention. A licensee is pursuing commercialization opportunities and clinical trials are being planned. However, these activities may be discontinued if applicant is forced to file an appeal. That is, the time and uncertainty regarding the appeal

process will likely result in the commercialization of applicant's invention suffering irreparable damage.

In summary, it is respectfully requested that the examiner reconsider his position and remove the final action. It is noted that as discussed above and previously, the Weed reference is not a proper 35 USC 103(a) reference in view of the prior amendments to the claims and the arguments forwarded above. Furthermore, the examiner appears to be applying hindsight and the teachings of applicant's disclosure to the Weed reference and as a consequence inferring disclosure that is simply not present in Weed. It is further noted that the examiner has maintained that filtering an aqueous extract of oatstraw is obvious in view of prior art dealing with extracts of herbs and such but has not provided any references which specifically teach a filtered aqueous extract of oatstraw. It is further maintained that the Weed reference does not teach or suggest filtering an aqueous extract of oatstraw and in fact teaches against filtering, as discussed above. The examiner's reason for rejection, that either Weed "does not teach that the particular method disclosed is the only method" or in the contrary that Weed's statement to include the whole oats is not a "strong statement" are simply not understood. Specifically, as discussed above, Weed says "yes, oats and all". The fact that Weed does not specifically say that this is the only way to do it does not change the fact that Weed does not teach or suggest filtering.

In view of the foregoing, further and more favorable consideration is respectfully requested.

Respectfully submitted

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